

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Rik Sagar
	:	
For	:	AUTOMATED RESERVATION SYSTEM
	:	WITH TRANSFER OF USER-PREFERENCES
	:	FROM HOME TO GUEST ACCOMMODATIONS
	:	
Serial No.:	:	09/966,613
	:	
Filed	:	September 27, 2001
	:	
Art Unit	:	3639
	:	
Examiner	:	Fadey S. Jabr
	:	
Att. Docket	:	US 018141
	:	
Confirmation No.	:	4776

APPEAL BRIEF

Mail Stop Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed December 29, 2006.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee, Koninklijke Philips Electronics, N.V. The assignment document is recorded at Reel 012228 and Frame No. 0329.

II. RELATED APPEALS AND INTERFERENCES

Following are identified any prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal:

NONE.

III. STATUS OF CLAIMS

This is an appeal from the final rejection of claims 1-25, mailed September 29, 2006. No other claims are pending. No claims are allowed.

IV. STATUS OF AMENDMENTS

All Amendments have been entered into the record.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 (independent – automated booking system for guest accommodations)

An automated booking system for guest accommodations, as claimed in independent claim 1, comprises: a guest accommodation which can be automatically booked by the system and used by a customer for a period of time (p. 1, ln. 31; p. 2, ln. 1-9); a provider network of a guest accommodations reservation provider having a database for customer preferences (Figure 4; p. 6, ln. 3-5); reserving means for communication between a home network and the provider network for

reserving the guest accommodations for a period of use (Figure 2; p. 1, ln. 29-32; p. 3, ln. 3-10; p. 6, ln. 6-19; p. 8, ln. 23-32; and p. 9, ln. 1-9); preference transmission means for transmitting customer preferences from a database of the home network to the database of the provider network (Figure 2; p. 2, ln. 3-9; p. 3, ln. 11-29; p. 6, ln. 6-19; and p. 13, ln. 25-31); and means for accessing the provider database for providing the accommodations depending on the customer preferences (p. 2, ln. 26-31; p. 3, ln. 11-14; and p. 13, ln. 7-24).

Claim 11 (independent – an automated booking system for guest accommodations)

An automated booking system for guest accommodations, as claimed in claim 11, comprises: a home network of a customer, the home network interconnecting home appliances having user programmable settings (Figure 3; p. 6, ln. 1-2); a guest accommodation which can be automatically booked by the system and used by the customer for a period of time and which can be provided with guest appliances (p. 1, ln. 31; p. 2, ln. 1-9); a provider network of an accommodations provider, the provider network having a database, the guest appliances of the guest accommodations are connected to the provider network (Figure 4; p. 6, ln. 3-5); reservation means in communication with a home network of a customer and the provider network for reserving the guest accommodations for a period of use (Figure 2; p. 1, ln. 29-32; p. 3, ln. 3-10; p. 6, ln. 6-19; p. 8, ln. 23-32; and p. 9, ln. 1-9); settings transmission means for transmitting the user programmable settings of the home appliances of the customer to the provider database (Figure 2; p. 2, ln. 3-9; p. 3, ln. 11-29; p. 6, ln. 6-19; and p. 13, ln. 25-31); and means for downloading the user programmable settings from the provider database into the guest appliances of the guest accommodations for programming the appliances of

the guest accommodations at the time of the customer's use of the accommodations (p. 2, ln. 26-31; p. 3, ln. 11-14; and p. 13, ln. 7-24).

Claim 25 (independent -- automated booking system for guest accommodations)

An automated booking system for guest accommodations, as claimed in claim 25, comprises: a home network having a database of customer preferences (Figure 3; p. 6, ln. 1-2); a guest accommodation which can be automatically booked by the system and used by the customer for a period of time (p. 1, ln. 31; p. 2, ln. 1-9); a provider network of a guest accommodations reservation provider having a database for customer preferences (Figure 4; p. 6, ln. 3-5); reserving means for communication between the home network and the provider network for reserving the guest accommodations for a period of use (Figure 2; p. 1, ln. 29-32; p. 3, ln. 3-10; p. 6, ln. 6-19; p. 8, ln. 23-32; and p. 9, ln. 1-9); preference transmission means for transmitting customer preferences from the data base of the home network to the database of the provider network (Figure 2; p. 2, ln. 3-9; p. 3, ln. 11-29; p. 6, ln. 6-19; and p. 13, ln. 25-31); and means for accessing the provider data base for providing the accommodations depending on the customer preferences (p. 2, ln. 26-31; p. 3, ln. 11-14; and p. 13, ln. 7-24).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

- A. Claims 1-7 are rejected under 35 U.S.C. § 102(c) as being allegedly anticipated by U.S. Publication No. 2003/0149576 to Sunyich et al., hereinafter "Sunyich."
- B. Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sunyich.

C. Claims 11-17 and 20-25 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sunyich in view of U.S. Publication No. 2003/0109938 to Daum et al., hereinafter "Daum."

D. Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being allegedly upatentable over Sunyich in view of Daum and U.S. Patent No. 4,899,373 to Lee et al., hereinafter "Lee."

VII. ARGUMENT

A. Rejection of Claims 1-7 Under 35 U.S.C. § 102(e)

The Final Office Action dated September 29, 2006, rejects claims 1-7 under 35 U.S.C. § 102(b) as being allegedly anticipated by Sunyich.

The Final Office Action dated September 26, 2006, alleged that the Declaration Under 37 C.F.R. § 1.131 filed on July 24, 2006, is ineffective to overcome Sunyich. Appellant respectfully disagrees for at least the following reasons.

"Priority goes to the first party to reduce an invention to practice unless the other party can show that it was the first to conceive the invention and that it exercised reasonable diligence in later reducing that invention to practice." *Price v. Symsek*, 988 F.2d 1187, 1190, 26 U.S.P.Q.2d 1031, 1033 (Fed. Cir. 1993). Under 37 C.F.R. § 1.131, "the inventor of the subject matter of the rejected claim . . . may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based." 37 C.F.R. § 1.131(a). "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the

invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” 37 C.F.R. § 1.131(b).

In the Final Office Action, the Examiner alleged that “the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Sunyuich reference.” While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Appellant respectfully submits that the declaration under 37 C.F.R. § 131 submitted in conjunction with an invention disclosure form submitted by the inventor to the patent department of Koninklijke Philips Electronics, N.V., is sufficient to establish conception at least as of April 30, 1999. Appellant has in fact established that the conception of the invention is “capable of proof,” to wit, the Declaration averred under penalty of 18 U.S.C. §1001 that the inventor conceived of the subject matter recited in the rejected claims at least as of April 30, 1999. Moreover, this statement is corroborated by the invention disclosure form submitted by the inventor, Rik Sagar, on April 30, 1999, and includes the title “service for transfer of user preferences from home to hotel.” Accordingly, Appellant submits that the evidence of the testimony in the Declaration filed July 24, 2006, in combination with the attachments and enclosures submitted therewith, has established conception at least as early as April 30, 1999.

In the Final Office Action, the Examiner also alleged that the “mere showing of an invention disclosure form submitted to the assignee’s patent department is insufficient to meet the requirements of due diligence.” The courts have recognized that “reasonable diligence is all that is required of the attorney.” *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 U.S.P.Q. 967, 970 (Fed. Cir. 1986). “It is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved; and if the attorney has a reasonable backlog of work which he takes up in chronological order and carries out expeditiously, that is sufficient.” *Rines v. Morgan*, 250 F.2d 365, 369, 116 U.S.P.Q. 145, 148 (C.C.P.A. 1957).

Appellant submits that the declaration filed on July 24, 2006, is sufficient to meet the standard of reasonable diligence up to the date of filing on September 27, 2001. Specifically, Appellant has averred under penalty of 18 U.S.C. § 1001 that the period from April 30, 1999, to the filing of the application was due to the backlog in the patent department of Koninklijke Philips Electronics. The period between conception and constructive reduction to practice was therefore due to a “reasonable backlog of work” taken “up in chronological order.” Thus, Appellant submits that the evidence of the testimony submitted in the Declaration filed July 24, 2006, has established constructive reduction to practice coupled with reasonable diligence from the date of conception.

Accordingly, since the showing of facts clearly establishes conception of Applicant’s invention prior to the effective date of Sunyich coupled with due diligence from prior to the effective filing date of Sunyich, Sunyich does not qualify as prior art. However, even assuming *arguendo* that Sunyich is available as a prior art reference, which it is not, Sunyich nevertheless fails to anticipate the rejected claims for at least the following reasons.

I. Claim 1

Claim 1 recites “preference transmission means for transmitting the customer preferences from a data base of the home network to the data base of the provider network.” This subject matter relates to transmission of customer preferences between a database located on a user’s home network and a remote database in the network of a provider. As shown in Figure 3, the home network includes a database containing user preferences. As further illustrated in Figure 4, the provider network includes a second distinct database for storing the preferences of guests.

Appellant respectfully submits that Sunyich does not disclose, teach, or suggest this subject matter. As illustrated in Figure 1, the system of Sunyich includes a preferences database which stores the hotel guest’s reservation preferences and environmental preferences. See section [0021]. This database is preferably a centralized database which is accessed by each hotel or frequently mirrored for each hotel. Id. In order to define preferences, the user enters preferences into the database via an electronic network interface or through a computer kiosk in the hotel. See section [0019]-[0020]. Accordingly, the system of Sunyich only allows a user to enter his or her preferences directly into the hotel database; a user cannot transmit preferences from a database on the home network to a remote database located in the network of the hotel. For example, if the user had preferences regarding preferred room temperature stored on a database on his or her home network, the system of Sunyich would require the user to enter these preferences into the database using either the electronic network interface or a computer kiosk. In other words, the system of Sunyich does not allow a user to transmit customer preferences from a database of the home network to the database of the provider network.

Consequently, Appellant respectfully submits that Sunyich does not disclose, teach, or suggest "preference transmission means for transmitting the customer preferences from a data base of the home network to the data base of the provider network," as recited in claim 1.

For at least the forgoing reasons, Appellant respectfully requests that the Board reverse the rejection of claim 1 under 35 U.S.C. § 102.

2. Claims 2-7

Claims 2-7 depend from claim 1 and are therefore also patentable for at least the reasons stated above in connection with claim 1, as well as for the separately patentable subject matter recited therein.

B. Rejection of Claims 9 and 10 Under 35 U.S.C. § 103(a)

The Final Office Action dated September 29, 2006, rejects claims 9 and 10 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sunyich.

Sunyich is not available as a prior art reference for the reasons stated above in connection with the rejection of claims 1-7 as allegedly being anticipated by Sunyich.

Claims 9 and 10 depend from claim 1 and are therefore also patentable for at least the reasons stated above in connection with claim 1, as well as for the separately patentable subject matter recited therein.

C. Rejection of Claims 11-17 and 20-25 under 35 U.S.C. § 103(a)

The Final Office Action dated September 29, 2006, rejects claims 9 and 10 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sunyich in view of Daum.

Sunyich is not available as a prior art reference against claims 11-17 and 20-25 for the reasons stated above in connection with the rejection of claims 1-7 as allegedly being anticipated by Sunyich. Even assuming *arguendo* that Sunyich is available as a prior art reference, which it is not, Sunyich in view of Daum nevertheless fails to disclose, teach, or suggest the subject matter of the rejected claims for at least the following reasons.

1. Claim 11

Claim 11 recites “settings transmission means for transmitting the user programmable settings of the home appliances of the customer to the provider data base.” This subject matter relates to transmission of customer preferences between a user's home appliances and a remote database in the network of a provider. As shown in Figure 3, the home network includes a number of appliances which include user programmable settings. As further illustrated in Figure 4, the provider network includes a database for storing the preferences of guests.

Appellant respectfully submits that Sunyich does not disclose, teach, or suggest this subject matter. As illustrated in Figure 1, the system of Sunyich includes a preferences database which stores the hotel guest's reservation preferences and environmental preferences. See section [0021]. This database is preferably a centralized database which is accessed by each hotel or frequently mirrored for each hotel. *Id.* In order to define preferences, the user enters preferences into the database via an electronic network interface or through a computer kiosk in the hotel. See section

[0019]-[0020]. Accordingly, the system of Sunyich only allows a user to enter his or her preferences directly into the hotel database; a user cannot transmit user programmable settings of home appliances to a remote database located in the network of the hotel. For example, if the user had preferences regarding the temperature settings for a refrigerator, the system of Sunyich would require the user to enter these preferences into the database using either the electronic network interface or a computer kiosk. In other words, the system of Sunyich does not allow a user to transmit user programmable settings of a home appliance to the database of the provider network.

Appellant respectfully submits that Daum also does not disclose, teach, or suggest this subject matter. The system of Daum allows the user to control home appliances remotely by transmitting commands to the appliance. See section [0002]. A network transmits command fields between the source and the appliance. See section [0008]. While the system of Daum allows for transmission of a command to a remote appliance, the system of Daum does not disclose, teach, or suggest transmitting user programmable settings to a database of a provider network. For example, while a user could send a command to a refrigerator to change the temperature, the system of Daum would not allow a user to transmit stored refrigerator settings to a remote database. Accordingly, Daum does not disclose, teach, or suggest transmitting user programmable settings of a home appliance to the database of the provider network.

Consequently, Appellant respectfully submits that the combination of Sunyich and Daum fails to disclose, teach, or suggest "settings transmission means for transmitting the user programmable settings of the home appliances of the customer to the provider data base," as recited

in claim 11. For at least the forgoing reasons, Appellant respectfully requests that the Board reverse the rejection of claim 11 under 35 U.S.C. § 103.

2. Claims 12-17 and 20-24

Claims 12-17 and 20-24 depend from claim 11 and are therefore also patentable for at least the reasons stated above in connection with claim 11, as well as for the separately patentable subject matter recited therein.

3. Claim 25

Claim 25 recites “preference transmission means for transmitting customer preferences from the data base of the home network to the data base of the provider network.” This subject matter relates to transmission of customer preferences between a database located on a user’s home network and a remote database in the network of a provider. As shown in Figure 3, the home network includes a database containing user preferences. As further illustrated in Figure 4, the provider network includes a second distinct database for storing the preferences of guests.

Appellant respectfully submits that Sunyich does not disclose, teach, or suggest this subject matter. As illustrated in Figure 1, the system of Sunyich includes a preferences database which stores the hotel guest’s reservation preferences and environmental preferences. See section [0021]. This database is preferably a centralized database which is accessed by each hotel or frequently mirrored for each hotel. Id. In order to define preferences, the user enters preferences into the database via an electronic network interface or through a computer kiosk in the hotel. See section [0019]-[0020]. Accordingly, the system of Sunyich only allows a user to enter his or her preferences directly into the hotel database; a user cannot transmit preferences from a database on the home

network to a remote database located in the network of the hotel. For example, if the user had preferences regarding preferred room temperature stored on a database on his or her home network, the system of Sunyich would require the user to enter these preferences into the database using either the electronic network interface or a computer kiosk. In other words, the system of Sunyich does not allow a user to transmit customer preferences from a database of the home network to the database of the provider network.

Appellant respectfully submits that Daum also does not disclose, teach, or suggest this subject matter. The system of Daum allows the user to control home appliances remotely by transmitting commands to the appliance. See section [0002]. A network transmits command fields between the source and the appliance. See section [0008]. While the system of Daum allows for transmission of a command to a remote appliance, the system of Daum does not disclose, teach, or suggest transmitting customer preferences from a home database to a database of a provider network. For example, while a user could send a command to a refrigerator to change the temperature, the system of Daum would not allow a user to transmit stored refrigerator settings to a remote database. Accordingly, Daum does not disclose, teach, or suggest transmitting customer preferences from a database of the home network to the database of the provider network.

Consequently, Appellant respectfully submits that the combination of Sunyich and Daum fails to disclose, teach, or suggest "preference transmission means for transmitting customer preferences from the data base of the home network to the data base of the provider network," as recited in claim 25. For at least the forgoing reasons, Appellant respectfully requests that the Board reverse the rejection of claim 25 under 35 U.S.C. § 103.

D. Rejection of Claims 18 and 19 under 35 U.S.C. § 103(a)

The Final Office Action dated September 29, 2006, rejects claims 18 and 19 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sunyich in view of Daum and Lee.

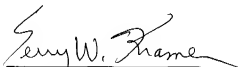
Sunyich is not available as a prior art reference for the reasons stated above in connection with the rejection of claims 1-7 as allegedly being anticipated by Sunyich.

Further, claims 18 and 19 depend from claim 11 and are therefore also patentable for at least the reasons stated above in connection with claim 11, as well as for the separately patentable subject matter recited therein.

E. Conclusion

For at least the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-25 are in condition for allowance. For at least the above reasons, Appellants respectfully request that this Honorable Board reverse the rejections of claims 1-25.

Respectfully submitted,
KRAMER & AMADO, P.C.



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February 20, 2007

Date

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VIII. CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. An automated booking system for guest accommodations, comprising:
 - a guest accommodation which can be automatically booked by the system and used by a customer for a period of time;
 - a provider network of a guest accommodations reservation provider having a data base for customer preferences;
 - reserving means for communication between a home network and the provider network for reserving the guest accommodations for a period of use;
 - preference transmission means for transmitting customer preferences from a data base of the home network to the data base of the provider network; and
 - means for accessing the provider data base for providing the accommodations depending on the customer preferences.
2. The system of claim 1 in which the guest accommodations are selected from: a hotel room with hotel facilities, a guest office with office facilities, a rental car package, an airline seat packages, a restaurant table package, and a train seat package.
3. The system in claim 1 in which the customer preferences include the configuration of the guest accommodations.

4. The system of claim 1 in which the customer preferences include preferences regarding the location of the guest accommodations with respect to features of the accommodations or the locations of accommodations of other guests.
5. The system of claim 1 in which the customer preferences include user programmable settings of consumer appliances in the guest accommodations.
6. The system of claim 1 in which the customer preferences include preferred contents of a refrigerator in the guest accommodation.
7. The system of claim 1 in which the customer preferences include preferred food and food preparation equipment in the guest accommodations.
8. The system of claim 1 in which the customer preferences include meal preferences.
9. The system in claim 1 in which the customer preferences include preferred office equipment or supplies in the guest accommodations.
10. The system of claim 1 in which the customer preferences include preferred configuration of the personal computer available in the guest accommodations.

11. An automated booking system for guest accommodations, comprising:

a home network of a customer, the home network interconnecting home appliances having user programmable settings;

a guest accommodation which can be automatically booked by the system and used by the customer for a period of time and which can be provided with guest appliances;

a provider network of an accommodations provider, the provider network having a data base, the guest appliances of the guest accommodations are connected to the provider network;

reservation means in communication with a home network of a customer and the provider network for reserving the guest accommodations for a period of use;

settings transmission means for transmitting the user programmable settings of the home appliances of the customer to the provider data base; and

means for downloading the user programmable settings from the provider data base into the guest appliances of the guest accommodations for programming the appliances of the guest accommodations at the time of the customer's use of the accommodations.

12. The system of claim 11 in which settings for a plurality of the customer's home appliances are transmitted, stored and downloaded into corresponding appliances of the accommodations that have functions similar to the corresponding home appliances.

13. The system of claim 11 in which the settings of a plurality of the customer's home appliances are analyzed to determine user programmable settings for appliances that are different from the customer's home appliances.

14. The system of claim 11 in which the home network includes a data base containing the user programmable settings of devices connected to the home network.

15. The system of claim 14 in which the home network includes means for communicating with the appliances connected to the home network for automatically determining the current user programmable settings prior to transmitting the settings.

16. The system of claim 11 further comprising:

a data base of the home network;

means for uploading the user programmable settings from the customer's home appliances into the data base of the home network;

an external network communicating with the home network and the provider network;

the user programmable settings are transmitted from the data base of the home network to the data base of the provider network through the external network.

17. The system of claim 16 in which the external network includes one or more of: a cable television network, a telephone network, and the internet.

18. The system of claim 11 in which the programmable settings include speed dial settings for making telephone calls by pushing fewer buttons than the number of digits in corresponding phone numbers.

19. The system of claim 11 in which the programmable settings include speed dial settings for dialing to send facsimiles by pushing fewer buttons than the number of digits in corresponding facsimile telephone numbers.

20. The system of claim 11 in which the programmable settings include environmental settings selected from one or more of temperature, humidity, and light level settings.

21. The system of claim 11 in which the programmable settings include a channel map for translating between sources of multimedia programming and means for selecting multimedia programming.

22. The system of claim 21 in which the means for selecting programming includes a plurality of buttons on a remote control and channel map allows the customer in the hotel room to use the same series of one or more remote control buttons to select a desired programming source as the series of the buttons he uses in his home to select that source.

23. The system of claim 11 in which the programmable settings include settings of software of a personal computer of the hotel room.
24. The system of claim 11 in which the programmable settings include security settings including a security code of a room alarm system.
25. An automated booking system for guest accommodations, comprising:
- a home network having a data base of customer preferences;
 - a guest accommodation which can be automatically booked by the system and used by the customer for a period of time;
 - a provider network of a guest accommodations reservation provider having a data base for customer preferences;
 - reserving means for communication between the home network and the provider network for reserving the guest accommodations for a period of use;
 - preference transmission means for transmitting customer preferences from the data base of the home network to the data base of the provider network; and
 - means for accessing the provider data base for providing the accommodations depending on the customer preferences.

IX. EVIDENCE APPENDIX

Listing and copies of evidence relied upon by the Examiner as to grounds of rejection to be reviewed on Appeal:

1. U.S. Publication No. 2003/0149576 to Sunyich et al.
2. U.S. Publication No. 2003/0109938 to Daum et al.
3. U.S. Patent No. 4,899,373 to Lee et al.

X. RELATED PROCEEDINGS APPENDIX

None.